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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,155	04/24/2001	Shogo Hyakutake	202319US2X	3275
22850	7590	01/26/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LIN, WEN TAI	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/840,155

Applicant(s)

HYAKUTAKE ET AL.

Examiner

Wen-Tai Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14-28 and 33-41 is/are rejected.
- 7) ☒ Claim(s) 10-13 and 29-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-41 are presented for examination.
2. The previous office action is withdrawn in response to Applicant's remarks filed 11/4/2004, which pointed out that Ito does not have an effective prior art date.
3. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

### ***Claim Rejections - 35 USC § 102***

4. Claims 1-5, 7-8, 19-24, 38 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Kulakowski [U.S. PGPub 20040100648].
5. Kulakowski was cited as prior art of record in the previous office action.
6. As to claim 1, Kulakowski teaches the invention as claimed including: a method of storing document information in an application service provider (ASP) which is connected to a user terminal [14, 28, Fig. 1] through a network, comprising the steps of:  
inputting said document information into said user terminal [e.g., 62, Fig.5];

inputting a previously created e-mail address into said user terminal, said e-mail address being confirmed by said ASP and corresponding to a storage location in said ASP [71-76, Fig.5]; and

sending said document information to said e-mail address via said network 96-98, Fig.5].

7. As to claims 2-5, Kulakowski further teaches that said step of inputting the document information comprises manually inputting said document information into said user terminal, said the step of manually inputting said document information comprises one of scanning and downloading said document information into said user terminal [e.g., 62, Fig.5; i.e., user manually inserts document into fax machine, followed by automatic scanning of the document into the fax machine], wherein said document information to a memory in said user terminal [72, Fig.5].

8. As to claims 7-8, Kulakowski further teaches that said step of inputting an e-mail address into said user terminal comprises typing said e-mail address into an alphanumeric keypad on said user terminal [paragraph 44], wherein said step of sending said document information to said e-mail address comprises sending the document information via the Internet [78-98, Fig.5].

9. As to claims 19-24, 38 and 40, since the features of these claims can also be found in claims 1-5 and 7-8 they are rejected for the same reasons set forth in the rejection of claims 1-5 and 7-8 above.

***Claim Rejections - 35 USC § 103***

10. Claims 6, 9, 18, 25-28, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski [U.S. PGPub 20040100648], as applied to claims 1-5, 7-8, 19-24, 38 and 40 above, further in view of official Notice.

11. As to claim 6, Kulakowski further teaches that said step of inputting a previously created e-mail address into said user terminal comprises storing said e-mail address in a memory of said user terminal [paragraph 43].

Kulakowski does not specifically teach associating said stored e-mail address with a quick send key on a keypad of said user terminal and inputting said e-mail address in response to a selection of said quick send key.

However, official Notice is taken that it is well known in the art that when sending email via an Internet Service Provider (ISP), the subscriber's PC is normally provided with a email agent for storing email address book in a local memory and a selected email address can be quickly entered into the "send to" or "copy to" fields by activating a quick send key (which may also be a predefined key on the alphanumeric keypad).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used such a quick send key for sending Kulakowski's email because the method is known to be convenient and could also prevent typos.

12. As to claim 9, Kulakowski does not specifically teach creating a storage folder for storing documents to said ASP.

However, official Notice is taken that storing data in various storage folder created by a user is well known in the art. For example, an Internet Service Provider (ISP) may offer each subscriber certain storage space for storing personal web pages, wherein a file manager is available for creating various subfolders for storing designated document types.

Since Kulakowski's ASP server needs to handle different subscribers' data and each subscriber may transfer different types of data or image into the server, it is obvious to one of ordinary skill in the art to have used the well known file manager to create different folders for different subscribers, and various subfolders under each subscriber's folder to record different type of document information, because this is a nominal approach for organizing large volume of data.

13. As to claim 18, Kulakowski does not specifically teach using an Internet facsimile machine for transmitting the document information as an attached e-mail, whereby an email address is provided for such purpose.

However, official Notice is taken that using Internet facsimile machine for transmitting the document information as an attached e-mail is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Internet facsimile machine for transmitting the document information because Internet facsimile protocol is well established and it has been widely used.

14. As to claims 25-28, 37 and 39, since the features of these claims can also be found in claims 1-6, 18-24, 38 and 40, they are rejected for the same reasons set forth in the rejection of claims 1-6, 18-24, 38 and 40 above.

15. Claims 14-17, 33-36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski [U.S. PGPub 20040100648], as applied to claims 1-9, 18-28 and 37-40 above.

16. As to claims 14-15, Kulakowski teaches that the local interface [10, 26, Fig.2] has the capability of sending the document information directly to the recipient's fax machine [steps 100-110, Fig.5] when the sender's email address is not found in the local directory [71, Fig.5].

Kulakowski does not specifically teach sending said document information to said e-mail address comprises sending said document information to said e-mail address concurrently with sending said document information to said user contact device.

However, it is well known in the art of communication by sending important information via different communication channels concurrently. Alternatively, it is also a nominal practice to notify the fax receiver of the anticipated material via a separate communication channel (e.g., in this case via a telephone).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make use of Kulakowski's co-existed communication channels (i.e., one via the Internet and the other via public telephone network) for sending the same document concurrently or notify the receiver of the upcoming event because by doing so it would improve the probability that the intended information be received in a timely fashion.

17. As to claims 16-17, 33-36 and 41, since the features of these claims can also be found in claims 1-9, 14-15, 18-28 and 37-40, they are rejected for the same reasons set forth in the rejection of claims 1-9, 14-15, 18-28 and 37-40 above.

18. Claims 10-13 and 29-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**19.** A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period



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for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

### ***Conclusion***

**Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

January 24, 2005

*Wen-Tai Lin*  
1/24/05